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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/599,974	02/14/1996	JEFFREY M. FRIEDMAN	600-1-162CP1	1513

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EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 05/21/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/599,974

Applicant(s)

FRIEDMAN ET AL.

Examiner

Eileen B. O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 1998.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 22 and 24-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 29-33, 50 and 53-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19, 21, 22 and 24-68 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Notice to Comply*.

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### **DETAILED ACTION**

1. Claims 1-19, 21, 22 and 24-68 are pending in the instant application. Claims 21, 22, 24, 27 and 34 have been amended, claims 20 and 23 have been canceled and claims 67 and 68 have been added as requested by Applicant in Paper Number 13, filed July 9, 1998.

Claims 1-19, 29-33, 59, 50 and 53-66 are withdrawn as being drawn to a non-elected invention.

Claims 21, 22, 24-28, 34-48, 51, 52, 67 and 68 are currently under examination.

### ***Sequence Compliance***

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Applicant is required to comply with the sequence rules, 37 CFR 1.821 - 1.825 within the period set forth for response to this Office Action. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Specifically, the claims do not comply with 37 CFR § 1.822(e) which states that "[a] sequence that is made up of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence". Applicant needs to provide a substitute computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences recited in the claims and specification of the instant application which are encompassed by these rules, a substitute paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. §§ 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). The instant specification and/or claims will also need to be amended so that they comply with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. For rules interpretation Applicant may call (703) 308-1123. See M.P.E.P. 2422.04.

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***Restriction Requirement***

3. It is noted that a First Action on the merits was mailed on Jan. 7, 1998, to which Applicants replied on July 9, 1998. However, the case has been transferred to a new Examiner, and restriction is required, because Applicants' claims are drawn to numerous patentably distinct polynucleotides encoding polypeptide sequences.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine splice variant OB-Ra polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- II. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine splice variant OB-Rb polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- III. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine splice variant OB-Rc polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- IV. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine splice variant OB-Rd polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.

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- V. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine splice variant OB-Re polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- VI. Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67, in so far as they are drawn to nucleic acids encoding murine full-length OB-R polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- VII. Claims 24, 25, 34-48, 51, 52 and 68, in so far as they are drawn to nucleic acids encoding human OB-R polypeptide, vectors, host cells and method of producing polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.

The inventions are distinct, each from the other because:

Although the classifications for these various nucleic acid molecules are overlapping, each represents a patentably distinct product encoding polypeptides with distinct physical and functional characteristics. Further, the search for more than one product would be burdensome, since each would require a separate amino acid and nucleic acid sequence search.

Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

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***Species Election for Groups I-V***

4. This application contains claims directed to the following patentably distinct species of the claimed invention: nucleic acids encoding hybrid polypeptides comprising murine OB-R splice variants OB-Ra-e. If any of Groups I-V is elected, Applicant must elect one species of hybrid receptor.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 22 and 26 are generic.

***Species Election for Group VII***

5. This application contains claims directed to the following patentably distinct species of the claimed invention: nucleic acids encoding human OB-R polypeptide having an amino acid substitution. If Group VII is elected, Applicant must elect one species of amino acid substitution as in claim 68.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 22 and 25 are generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312.

The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

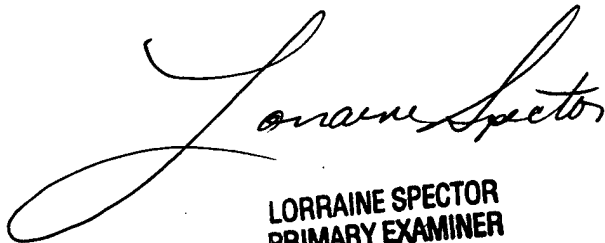
Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner



LORRAINE SPECTOR  
PRIMARY EXAMINER